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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,748	10/04/2000	Makoto Sakakibara	54030USA7A.0	3966

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/647,748

Applicant(s)

SAKAKIBARA, MAKOTO

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 5/6/2004. Applicants' amendments to the specification, claims 1 and 2, cancellation of claim 6, and newly added claims 7-9 have all been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, upon reconsideration, the Examiner notes that Applicant's amendments and arguments overcome the prior 103(a) rejection over Nitto Denko Corp in view of Canary, and the rejection is withdrawn. However, Applicants' arguments are moot in view of the new grounds of rejection, as follows.

Claim Objections

4. Claim 1 objected to because of the following informalities:

In claim 1, line 5, please change "said second layer" to --said second paper layer--, so as to provide proper antecedent basis. Similarly, at line 9, please change "first layer" to --first paper layer--.

In claim 1, near the end of line 10, please change "to pulp" to --to wood pulp--, so as to be consistent in blend composition for comparing blend ratios in different layers.

Appropriate correction is required.

Response to Amendment

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Mayer et al. (US 4012281).

Mayer's invention is directed to an improved laminate (Abstract). Mayer shows in Figs. 1 and 2 that the top layer 11 consists of fibrous material 12. The fibrous material are standard wood pulp fibers. The bottom layer 14 comprises wood pulp and synthetic fibers (column 2, lines 36-46), and the length of the synthetic fibers are from 1/8 inch to 1 inch (column 1, lines 64-65). Suitable synthetic fibers include rayon fibers, polyester fibers, etc. (column 3, lines 26-28).

Claim 1 lacks novelty.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Burton et al. (US 4140566).

Burton's invention is directed to a reinforced wall or ceiling covering comprising a two-ply laminate. The first ply consists of a paper sheet containing 60-100% by weight of wood pulp fibers and 0-40% discontinuous synthetic fibers. The second ply consists of a sheet of 10-60% wood pulp fibers, and 40-90% of synthetic fibers (Abstract). The synthetic fibers have a length less than 20 mm (column 2, lines 5-9), and may be selected from the group consisting of polyolefins, polyamides, polyesters, polyurethanes, polycarbonates, vinyl and acrylic resins (column 2, lines 14-16).

Claim 1 lacks novelty.

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7. Claims 2-3, 5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over XP 002112333 in view of Burton et al. (US 4140566).

The teachings of Burton are again relied upon as set forth above.

The invention of XP '333 relates to a masking tape, which teaches that a thin porous sheet paper made of wood pulp and short synthetic fiber such as rayon fibers, polyester fibers, etc. (page 1, lines 1-6). XP '333 also teaches that layers are impregnated with different amounts of rubber and/or synthetic resin, so as to provide one surface having high mechanical strength, and the other surface having high compatibility to be coated with an adhesive layer (page 1, lines 17-21), as a masking adhesive sheet (page 2, line 1). The adhesive tape is capable of being released from the surface without tearing and breaking (page 1, lines 23-24).

For claims 2-3, 5 and 7-9, XP '333 teaches all the features of the instantly claimed invention, except the use of a two-layer paper backing. However, it is noted that Burton teaches a two-ply laminate, as set forth above. Burton also teaches that the pulps used to produce both plies in the laminate may also contain other usual additives such as binders, etc. (column 2, lines 26-28). Further, Burton teaches that since one of the ply has a high synthetic fiber content, the wall-covering is dry-strippable from the wall, i.e., it has high mechanical strength (column 1, lines 35-37). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art of adhesive tape paper backing to substitute the backing of XP '333 with Burton's two-ply laminate, which has different properties at opposite faces, motivated by the desire to obtain a different mechanical strength in the outer layers for improved release

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property without tearing and breaking, as taught by XP '333. It should be noted that substituting a known equivalent material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition, the following references are cited of interest for making paper adhesive tape having two layered backing:

JP 58160382A is directed to a two-layered paper backing for an adhesive tape. One layer has greater tensile strength in length direction, and the other layer has greater tensile strength in width direction.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

VSC

Victor S Chang

Examiner

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7/14/2004



TERREL MORRIS
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